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D. REMARKS

Status of the Claims

Claims 1, 2, 4-7, 9-12, 14, 16-24 and 55-65 are pending in the application. Claims 1, 2, 4-7, 9-11, 16, 19, 22, 55 and 60 are amended. Claims 3, 8, 13, 15 and 25-54 are canceled.

Amendments to the Specification

Applicants respectfully request entry of the amendment to the specification to correct a typographical error; Atel@ should read "tel".

Interview Summary

On November 1, 2005 at 10:30 AM EST, Applicants' representative Amy J. Pattillo conducted a telephone interview with Examiner Barry Taylor. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and Examiner Taylor discussed the portion of the rejection of claims 1, 6, and 11 starting on page 5, paragraph 3 through page 6, paragraph 1 of the Office Action reading:

According to Applicants, Morganstein in view of Kurganov fail to teach detecting a context for a call from a first part to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call (see page 34, paper dated 5/25/05). The Examiner is not sure what Applicants mean? The Examiner has performed a text search of Applicants specification and the terms "a third party subscribes to a telephone service" cannot be found? It appears that a subscriber sets up parameters for the network (i.e. third party) to use. The Examiner notes that the terms "particular line specified by said third party" do not appear in any paragraphs either (i.e. also silent in specification).

Applicants' representative noted that throughout the Office Action, the Examiner cites terms and states that the Examiner is not sure what the Applicants mean. Applicants requested clarification of whether the Examiner intended to reject claims 1, 6, and 11 under a 112 rejection or whether, through these statements, the Examiner is pointing out the basis for the Examiner's interpretation of the scope of the claims. The Examiner replied that the rejection is not intended

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to be a 112 rejection, but the rejection indicates portions of the invention that the Examiner does not understand. The Examiner requested that in a next response that Applicants cite portions of the specification, and not just the claim language itself, that support Applicants' assertions that the claims are not taught by Morganstein in view of Kurganov. Applicants' representative responded that when the claims were amended to include the terms "a third party subscribe to a telephone service", Applicants also cited the portions of the specification supporting the amendments; however, Applicants noted that the supporting references in the previous response were directed to the page and line numbering of the originally filed document and therefore Applicants agreed to update the references to the page and paragraph numbering of the published document.

In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

Double Patenting

The Examiner rejects claims 1-2, 4-7, 9-12, 14, 16-26, 30-36, 40-46, and 50-65 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of US Patent No. 6,917,672 B2 (Brown et al. hereinafter Brown). [Office Action, p. 2. As grounds for the rejection, the Examiner states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-39 [of] Brown are similar in scope to claims 1-2, 4-7, 9-12, 14, 16-26, 30-36, 40-46, and 50-65 of the present application with various wording variations.

For example, the present application generally claims a method for regulating calls, comprising: detecting a context for a call from a first party to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call and Brown generally claims a method for regulating calls, comprising: detecting an identity of a caller to a call and an identity of a callee logged in to receive [said] call.

The present application generally claims comparing said context for said call with a selection of context based criteria for said particular line specified by said third party and Brown generally claims accessing a selection of third party criteria for regulating a call between said caller identity and said callee identity.

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The present application generally claims only establishing a communication channel between said first party and said second party through said particular line if said context is acceptable within said selection of context based criteria and Brown generally claims regulating a communication channel between said caller and said callee according to said selection of third party criteria. [Office Action, pp. 2-3]

Applicants are filing a terminal disclaimer in compliance with 37 CFR 1.321(c) together with this response to overcome the double patenting rejection. Applicants respectfully request withdrawal of the rejection and allowance of the claims in view of the terminal disclaimer.

Lack of Obviousness under 35 USC § 103(a)

1. Claims 1-2, 4-7, 9-12, 14, and 16-24 are not obvious under Morganstein in view of Kurganov or Trossen

Claims 1-2, 4-7, 9-12, 14, 16-26, 30-36, 40-46, and 50-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morganstein (US Patent Number 5,724,408) in view of Kurganov (US Patent Number 6,807,257) or Trossen (US Patent Number 6,665,723). Claims 35-54 are canceled. The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that claims 1-2, 4-7, 9-12, 14, and 16-24 are not obvious under Morganstein in view of Kurganov or Trossen and therefore the rejection should be withdrawn and the claims allowed.

Claims 1, 6, and 11

With regards to claims 1, 6, and 11, independent method claim 1, which is representative of independent system claim 6 and independent computer program product claim 11, with regard to similarly recited subject matter and rejection, reads as follows:

1. (Currently Amended) A method for regulating calls, comprising:
receiving, at a context regulation service, a request to determine regulation requirements for a call from a network switch;
detecting, at a context regulation service, a context for [[a]] said call from a first party to a second party via a particular line, wherein a third party different

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from said first party is a line subscriber[[s]] to said particular line [[a telephone service]] made available to said first party for said call;
accessing, at said context regulation service, a selection of context based criteria specified by said third party for said particular line;
comparing, at said context regulation service, said context for said call with [[a]] said selection of context based criteria for said particular line specified by said third party; and
only directing, by said context regulation service, for said network switch to establish[[ing]] a communication channel between said first party and said second party through said particular line if said context is acceptable within said selection of context based criteria.

The Examiner cites Morganstein, in the abstract, col. 3, lines 27-32, col. 3 line 33-col. 4, line 63, col. 5, lines 1-36, col. 6, lines 24-65, col. 6 lines 4-12, col. 6, lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58, as disclosing “detecting a context for a call from a first party to a second party”, “comparing the context for the call with a selection of context based criteria for particular line”, and “only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria.”[Office Action, pp. 4-5] The Examiner states that Morganstein does not “explicitly show regulating calls”, but cites Kurganov as teaching:

“a method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time (col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network-based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67).” [Office Action, p. 5]

The Examiner further states:

According to Applicants, Morganstein in view of Kurganov fail to teach detecting a context for a call from a first part to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call (see page 34, paper dated 5/25/05). The Examiner is not sure what Applicants mean? The Examiner has performed a text search of Applicants specification and the terms “a third party subscribes to a telephone

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service” cannot be found? It appears that a subscriber sets up parameters for the network (i.e. third party) to use. The Examiner notes that the terms “particular line specified by said third party” do not appear in any paragraphs either (i.e. also silent in specification).

Trossen teaches an external trusted party (i.e. third party) call processing environment (title, abstract). Trossen invention relates to an extension to call processing that enable trusted third-party entity to perform context-specific call processing (col. 3, lines 23-40, col. 3, line 62-col. 4, line 34) to be used thereby allowing specific user to reject callers or certain calling phone numbers (col. 4 lines 35-67). [Office Action, pp. 5-6]

The Examiner concludes:

It would have been obvious for anyone of ordinary skill in the art at the time of the invention to utilize the teachings of Kurganov or Trossen into the teachings of Morganstein in order to provid[e] for a more flexible system that allows subscribers the ability to predefine context-specific information to be used by [an] external trusted party so that only calls from the trusted party are received.” [Office Action, p. 6]

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Applicants respectfully assert that the Examiner does not prove a prima facie case of obviousness as to claims 1, 6, and 11, and therefore Applicants respectfully request removal of the rejection and allowance of the claims.

Morganstein in view of Kurganov or Trossen do not teach or suggest each and every element of claims 1, 6, and 11

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

First, Applicants previously asserted in the response dated 5/25/05 and continue to assert that the Examiner’s statement that the element missing in the teachings of Morganstein is

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“regulating calls” is incorrect, leading to a rejection that does not show how Morganstein in view of Kurganov or Trossen teaches or suggests each and every element of claim 1. The Examiner cites Morganstein as teaching the elements of claim 1, except for the elements, prior to amendment, of wherein a third party subscribes to a telephone service made available to said first party for said call and a selection of context based criteria for said particular line specified by said third party. The Examiner improperly summarizes these elements as “regulating calls” and cites Kurganov or Trossen as teaching “regulating calls”. These elements of claim 1, when claim 1 is considered as a whole, do not merely teach “regulating calls”. In particular, when claim 1 is considered as a whole, claim 1 teaches that the third party supplies the line used by the first party, or caller, for an outgoing call and that a communication channel is allowed to open for an outgoing call from the first party to the second party only if the context of the call between the first party and the second party is acceptable within a selection of context based criteria specified by the third party for the line.

Second, Applicants previously asserted in the response dated 5/25/05 and continue to assert that neither Morganstein nor Kurganov, separately or in combination, teaches regulating outgoing calls placed by a first party according to third party context based criteria specified by a third party subscribing to the telephone service made available to the first party. First, Morganstein only discloses routing of an incoming call, not regulating outgoing calls. (See Morganstein abstract and col. 2, lines 15-59 where Morganstein enables a user to set how an incoming call is handled based on the caller telephone number, but does not describe regulating outgoing calls). Second, Kurganov discloses a network through which a unified messaging service follows a subscriber to multiple devices. (See Kurganov abstract and col. 2 lines 29-34 and lines 42-46). Kurganov describes that a user may have a cellular phone, a pager, a computer, a fax machine, an electronic mailbox on the internet, and a voice mail service and Kurganov provides a unified messaging service accessible from any standard communication device (telephone, computer, internet). (Kurganov col. 2 lines 9-21, 29-34, and 42-46). In the area of outgoing calls, Kurganov describes that the unified messaging service provides a “contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you

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are.” (Kurganov col. 3, lines 8-10). Thus, Kurganov discloses that a subscriber, or first party placing a call, may access the unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. Kurganov does not teach a third party subscriber to the telephone service used by the first party to place the call where the third party subscriber specifies context based criteria for regulating whether a communication channel is opened by the telephone service for the call to a second party. In contrast, claims 1, 6, and 11 teach that the third party supplies the line used by the first party for an outgoing call and that a communication channel is allowed to open for the outgoing call from the first party to the second party only if the context of the call between the first party and the second party is acceptable within a selection of context based criteria specified by the third party for the line.

Applicants note that the Examiner provides an interpretation of this previous assertion in the current Office Action, which reads:

According to Applicants, Morganstein in view of Kurganov fail to teach detecting a context for a call from a first part to a second party via a particular line, wherein a third party subscribes to a telephone service made available to said first party for said call (see page 34, paper dated 5/25/05). The Examiner is not sure what Applicants mean? The Examiner has performed a text search of Applicants specification and the terms “a third party subscribes to a telephone service” cannot be found? It appears that a subscriber sets up parameters for the network (i.e. third party) to use. The Examiner notes that the terms “particular line specified by said third party” do not appear in any paragraphs either (i.e. also silent in specification). [Office Action, p. 5]

Applicants note that during the Interview, Applicants’ representative requested clarification from the Examiner whether the Examiner intended to reject claims 1, 6, and 11 and the other claims pending in the application under 35 USC 112. The Examiner indicated that he did not intend to reject claims 1, 6, and 11 under 35 USC 112 and that his comments indicate the portions of the claims he did not understand. Therefore, Applicants assert that claims 1, 6, and 11 are properly supported by the specification and are definite, pointing out and distinctly claiming the subject matter Applicants regard as the invention under 35 USC 112.

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While Applicants continue to assert that the Examiner has not established a prima facie case of obviousness and the claims prior to amendment were properly supported by the specification, Applicants amend claims 1, 6, and 11 for purposes of clarification.

First, Applicants respectfully assert, contrary to the Examiner's position, that the specification does support the phrase "third party subscribes to a telephone service" in the description, where the third party is the line subscriber to the telephony device used by a first party, as described in paragraphs 0031, 0038, 0118, 0141, and 0196. To further clarify claims 1, 6, and 11, however, Applicants amend claims 1, 6, and 11 to the element of wherein a third party different from said first party is a line subscriber to said particular line made available to said first party for said call, which is also supported throughout the specification, and for example, in paragraphs 0031, 0038, 0118, 0141 and 0196.

Second, Applicants respectfully disagree with the Examiner's statement that the terms "particular line specified by said third party" do not appear in any paragraphs; paragraphs 0012, 0101, 0148, 0196 teach accessing a selection of context based criteria specified by the third party line subscribers for the particular line. To further clarify claims 1, 6, and 11, however, Applicants amend claims 1, 6, and 11 in the element of accessing, at said context regulation service, a selection of context based criteria specified by said third party for said particular line, which is supported throughout the specification, and for example, supported in paragraphs 0101, 0148, and 0196.

Applicants also amend claims 1, 6, and 11 to clarify that a determination of whether to establish a communication channel for a call is triggered by a request from a network switch handling the call, in the element of receiving, at a context regulation service, a request to determine regulation requirements for a call from a network switch, which is supported throughout the specification, and for example, supported in paragraphs 0140, 0175, and 0195. In addition, Applicants amend claims 1, 6, and 11 to clarify that the service triggered to determine regulation requirement for the call directs the network switch whether to establish a communication channel for the call, in the element of only directing, by said context regulation service, for said network switch to establish a communication channel between said first party

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and said second party through said particular line if said context is acceptable within said selection of context based criteria, which is supported throughout the specification, and for example, in paragraphs 0140, 0143, 0175, 0176, 0197, and 0198.

Returning to the Examiner's grounds of rejection of claims 1, 6, and 11, Applicants further assert that neither Morganstein nor Trossen, separately or in combination, teaches regulating outgoing calls placed by a first party according to third party context based criteria specified by a third party subscribing to the telephone service made available to the to the first party. Trossen is titled "External Trusted Party Call Processing in SIP Environments". The abstract of Trossen, lines 1-3 describes the scope of Trossen of "[a] method for outsourcing Internet call processing functions from a session initiation protocol (SIP)-compliant proxy to a third-party call processing entity. Thus, while Trossen does describe an external trusted party or "third-party call processing entity" that performs call regulation within an SIP environment, this "third-party call processing entity" is not a third party that is the line subscriber to the line used by a first party and is not a third party that sets the context based criteria for regulating calls placed from the line. Applicants note that from the Examiner's statement that "It appears that a subscriber sets up parameters for the network (i.e. third party) to use" the Examiner interpreted the "third party" as the network, which the Examiner further interpreted to encompass the "third-party call processing entity". [Office Action, p. 5] Applicants continue to assert that the specification clearly indicates that the third party, in the context of regulating outgoing calls, is the line subscriber for the particular line being regulated and that the third party sets the context based criteria for regulating the particular line. Even if the line subscriber sets up the parameters for the network to use in regulating the call, the claims previously indicated that the line subscriber, and not the network, is the third party and the amendments to the claims further clarify the line subscriber is the third party.

In conclusion, a prima facie case of obviousness under 103(a) is not established for claims 1, 6, and 11 because at least one element of claims 1, 6, and 11 is not taught by Morganstein and Kurganov or Trossen, separately or in combination. Because a prima facie case

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of obviousness under 103(a) is not established for the claims 1, 6, and 11, Appellants respectfully request withdrawal of the rejection and allowance of claims 1, 6, and 11.

**There is No Reasonable Expectation of Success in the Proposed Combination of
Morganstein by Kurganov or Trossen**

In addition, to establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants respectfully assert that there is no reasonable expectation of success in the Examiner's proposed combination of Morganstein by Kurganov or Trossen because none of Morganstein, Kurganov, or Trossen discloses that a third party is the line subscriber to the line used by the first party to the outgoing call or comparing the context of the call with context based criteria specified by the third party for the particular line. Morganstein describes a call recipient side call screening system for matching a caller ID of a call with a list of caller IDs and routing the call according to the routing instruction assigned to the caller ID. *Morganstein*, abstract, col. 2, lines 15-59. Kurganov discloses that a subscriber, or first party placing a call, may access a unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. *Kurganov*, abstract, col. 2 lines 9-21, 29-34, 42-46, col. 3, lines 8-10). Trossen discloses "a method for outsourcing Internet call processing functions from a session initiation protocol (SIP)-compliant proxy to a third-party call processing entity." *Trossen*, abstract. None of Morganstien, Kurganov, or Trossen discusses that a third party line subscriber may set the criteria for regulating outgoing calls by a first party from a particular line. Further, Applicants respectfully assert that the Examiner's statement of the combined invention of Morganstein and Kurganov or Trossen shows there is not any expectation of success for the proposed combination of references to teach the claimed invention. The Examiner's statement of the proposed modification "in order to provid[e] for a more flexible system that allows subscribers the ability to predefine context-specific information to be used by [an] external trusted party so that only calls from the trusted party are received" [Office Action, p. 6] does not indicate the basis of modification of Morganstein by Kurganov or Trossen to teach each and

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every element of claims 1, 6, and 11, including regulating outgoing calls placed by a first party iv a line subscribed to by a third party by comparing the context of a call between the first party and a second party with context based criteria specified by a third party subscriber for the line. Therefore, the lack of teaching in the references themselves and the Examiner's conclusion as to the combined invention taught by Morganstein as modified by Kurganov or Trossen shows that there is a lack of reasonable expectation of success in the proposed combination. As a result, the combination of Morganstein and Kurganov or Trossen cannot establish a prima facie case of obviousness and the rejection of claims 1, 6, and 11 should be withdrawn.

Claims 2, 4, 5, 7, 9, 10, and 12

Regarding claims 2, 4, 5, 7, 9, 10, and 12, Applicants respectfully propose that because claims 1, 6, and 11 are not obvious under Morganstein in view of Kurganov or Trossen, as claims dependent upon claims 1, 6, and 11, claims 2, 4, 5, 7, 9, 10, and 12 are not obvious under Morganstein in view of Kurganov or Trossen and the dependent claims should be allowed.

In addition, Applicants note that claims 2 and 7 are amended to reflect amendments to claims 1 and 6 to maintain proper antecedent basis.

Further, Applicants note that claims 4 and 9 are amended to read wherein said context regulation service is communicatively accessible to said network switch outside a trusted telephone network handling said call via a secure communication gateway to a packet-switching network. The specification supports the amendment throughout, and for example, in paragraphs 0033, 0043, 0045, 0047, 0057, 0058, 0070, and 0088 and Figures 3 and 8. Additionally, Applicants respectfully assert that none of Morganstein, Kurganov, or Trossen, separately or in combination, teach or suggest that a network switch within a trusted telephone network accesses the context regulation service in a packet switching network via a secure communication gateway. Applicants respectfully request allowance of amended claims 4 and 9.

In addition, Applicants note that claims 5 and 10 are amended to read wherein said context for said call indicates whether said call is a business related call by said first party and said selection of context based criteria specifies at least one rule for regulating calls over said

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particular line if said call is a business related call and at least one other rule for regulating calls over said particular line if said call is not a business related call. The specification supports the amendment throughout, and for example, in paragraphs 0098, 0099, 0128, 0129, 0145, and 0191. Additionally, Applicants respectfully assert that none of Morganstein, Kurganov, or Trossen, separately or in combination, teach or suggest detecting a call context indicating whether a call is business related and regulating the call based on at least one rule if the call is business related or at least one other rule if the call is not business related. Applicants respectfully request allowance of amended claims 5 and 10.

Claim 14

With regard to claim 14, claim 14 currently reads:

14. (Original) A method for regulating outgoing calls, comprising:
 detecting an identity of a party called via a particular line;
 determining a selection of third party criteria governing calls via said particular line according to said identity of said called party; and
 only establishing a communication channel via said particular line between a calling party and called party if said called party is acceptable within said selection of third party criteria.

In the rejection of claim 14, the Examiner states that "Morganstein fails to show third party criteria." [Office Action, p. 8] The Examiner then cites Kurganov as teaching:

"a method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time (col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67)." [Office Action, p. 8]

The Examiner further states that:

According to Applicants, Morganstein in view of Kurganov fail to teach regulating telephone calls via third party criteria (see page 38 of paper dated

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5/25/05). The Examiner is not sure what Applicants mean? The Examiner has performed a text search of Applicants specification and the terms "detecting an identity of a party called via a particular line" cannot be found? The Examiner notes that Applicants conflicting patent (see Double Patenting listed above) teaches utilizing a line for [a] call to determine identity (see conflicting patent 6,917,672 Brown et al especially col. 24 lines 12-15). The Examiner performed a text search of Applicants specification and cannot find "determining a selection of third party criteria governing calls via said particular line according to said identity of said called party." Furthermore, the Examiner cannot find the term "channel" in the same paragraph as the term "line." It appears, that a subscriber sets up parameters for the network (i.e. third party) to use. [Office Action, pp. 8-9]

The Examiner cites Trossen as teaching:

An external trusted party (i.e. third party) call processing environment (title, abstract). Trossen invention relates to an extension to call processing that enable trusted party third-party entity to perform context-specific call processing (col. 1, lines 5-10, lines 57-62, col. 2, lines 12-15, line 42). Trossen teaches that by outsourcing call processing to trusted third party allows for context-specific information such as location-based call processing and mood-based call processing (col. 3, lines 23-40, col. 3 line 62-col. 4 line 34) to be used thereby allowing specific user to reject callers or certain calling phone numbers (col. 4 lines 35-67). [Office Action, p. 9]

The Examiner concludes:

It would have been obvious for anyone of ordinary skill in the art at the time of invention to utilize the teachings of Kurganov or Trossen into the teachings of Morganstein in order to provid[e] for a more flexible system that allows subscribers the ability to predefine context-specific information to be used by external trusted party so that only calls from the trusted party are received. [Office Action, p. 9]

Morganstein combined with Kurganov or Trossen does not teach or suggest all the limitations of Claim 14

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that prima facie obviousness is not

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established because Morganstein in view of Kurganov or Trossen does not teach any of the claim limitations when claim 14 is considered as a whole.

First, Applicants previously asserted in the response dated 5/25/05 and continue to assert that the Examiner fails to establish a case of prima facie obviousness for claim 14 because Morganstein does not teach all the elements of claim 14, except for "third party criteria." In the rejection of claim 14, the Examiner assumes that Morganstein teaches claim 14, except for "third party criteria". [Office Action, p. 5] While the Examiner does not point to which sections of Morganstein teach all the elements of claim 14 except for "third party criteria", Applicants traverse the rejection and assert that when considered as a whole, claim 14 teaches regulating an outgoing call placed via a particular line based on the third party criteria governing calls via the outgoing line according to the identity of the called party receiving the call. Morganstein, in contrast, discloses call screening of incoming calls to a particular line based on the telephone number of the calling party, not regulating outgoing calls from a particular line. (See Morganstein col. 2, lines 15-59). Morganstein enables a user to set how an incoming call is handled based on the caller telephone number. (See Morganstein, abstract). Therefore, because Morganstein does not teach outgoing call regulation, Morganstein does not teach each element of claim 14 except for "third party criteria".

Second, Applicants previously asserted in the response dated 5/25/05 and continue to assert that the Examiner fails to establish a case of prima facie obviousness for claim 14 because Kurganov does not teach "third party criteria" when claim 14 is interpreted as a whole and "third party criteria" is applied to regulating an outgoing call. In particular, as Applicants noted in the response to the rejection of claim 1, Kurganov discloses that a subscriber, or first party placing a call, may access a unified messaging service from any telephone device, and that the unified messaging service subscribed to by the first party provides a contact database for facilitating the placing of calls. (See Kurganov, abstract and col. 2 lines 9-46). Kurganov does not teach detecting the actual identity of the party answering a call, selecting from among the third party criteria based on the actual identity of the party answering the call, and enabling the call based on the criteria. In contrast, claim 14 teaches detecting the identity of the called party, selecting

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criteria according to the identity of the called party as set by a third party regulating outgoing calls from the particular line and only establishing a communication channel from the calling party to the called party if the identity of the called party is acceptable within the criteria. Therefore, because Kurganov does not teach regulating an outgoing call according to "third party criteria", Morganstein combined with Kurganov does not teach or suggest each element of claim 14.

In conclusion, Morganstein in view of Kurganov does not teach outgoing call regulation based on third party criteria applied to an outgoing call line. Therefore, prima facie case of obviousness under 103(a) is not established for claim 14 because at least one element of claim 14 is not taught. Because a prima facie case of obviousness under 103(a) is not established for claim 14, Appellants respectfully request allowance of claim 14.

With regard to claim 14, Applicants note the Examiner's statement:

According to Applicants, Morganstein in view of Kurganov fail to teach regulating telephone calls via third party criteria (see page 38 of paper dated 5/25/05). The Examiner is not sure what Applicants mean? The Examiner has performed a text search of Applicants specification and the terms "detecting an identity of a party called via a particular line" cannot be found? The Examiner notes that Applicants conflicting patent (see Double Patenting listed above) teaches utilizing a line for [a] call to determine identity (see conflicting patent 6,917,672 Brown et al especially col. 24 lines 12-15). The Examiner performed a text search of Applicants specification and cannot find "determining a selection of third party criteria governing calls via said particular line according to said identity of said called party." Furthermore, the Examiner cannot find the term "channel" in the same paragraph as the term "line." It appears, that a subscriber sets up parameters for the network (i.e. third party) to use. [Office Action, pp. 8-9]

In the Interview, as previously discussed, the Examiner stated that his notations throughout the rejections of the claims indicating lack of understanding of the claims are not intended as a rejection under 35 USC 112. The Examiner requested that Applicants indicate specific portions of the specification, and not just the claim language itself, in support of Applicants' assertions as to reasons that Morganstein in view of Kurganov fail to teach all the elements of claim 14. Applicants agreed to consider clarifying comments with portions of the specification.

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Applicants assert, however, that claim 14 is properly supported by the specification and are definite, pointing out and distinctly claiming the subject matter Applicants regard as the invention under 35 USC 112.

Further, Applicants respectfully assert that if “third party” is interpreted as the network, the Examiner still fails to show how the combination of Morganstein and Kurganov or Trossen teaches outgoing call regulation.

Claims 16, 19, and 22

With regards to claims 16, 19, and 22, independent method claim 16, which is representative of independent system claim 19 and independent computer program product claim 22, with regard to similarly recited subject matter and rejection, reads as follows:

16. (Currently Amended) A method for screening calls, comprising:
 detecting a context for a call from a first party to an intended second party,
 wherein said context indicates at least one from among a location of said first
 party, a type of telephony device used by said first party, and a device used to
 authenticate an identity of said first party; [[and]]
 responsive to said context requiring prescreening of said call, transferring
 said call to a screening party;
 detecting an authenticated identity of said screening party;
 adjusting said context to indicate said identity of said screening party and
 said regulated path to said screening party; and
 distributing said adjusted context to said intended second party.

In the rejection of claims 16, 19, and 22, the Examiner cites Morganstein as teaching:

“detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 5 lines 1-36, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”,
 “comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)”, and “only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58).” [Office Action, p. 10]

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The Examiner notes, however, that Morganstein does not explicitly show a “call screener”.

[Office Action, p. 10] The Examiner then cites Kurganov as teaching:

A method and apparatus for a computer and telecommunications network (Title, abstract) that allows subscribers the ability to send and receive messages, access information and entertainment, conduct business transactions, organize daily schedules and stay in touch with homes and offices from anywhere at any time (col. 1 lines 26-56) from any standard communication device (col. 2 lines 24-34). Kurganov discloses the network based solution provides a contact database facilitating the placing of calls, screening of calls, and tracking you down wherever you are (col. 3 line 5- col. 4 line 63). Kurganov uses voice recognition software, standard touchtones, and internet for allowing subscribers access to features (col. 4 line 64 – col. 6 line 67). [Office Action, pp. 10-11]

The Examiner states that “According to Applicant, Morganstein in view of Kurganov fail to teach wherein the context includes location of first party (see page 42, paper dated 5/25/05).”

[Office Action, p. 11] Next, the Examiner cites Trossen as teaching:

An external trusted party (i.e. third party) call processing environment (title, abstract). Trossen invention relates to an extension to call processing that enable trusted third-party entity to perform context-specific call processing (col. 1, lines 5-10, lines 57-62, col. 2, lines 12-15, line 42). Trossen teaches that by outsourcing call processing to trusted third party allows for context-specific information such as location-based call processing and mood-based call processing (col. 3 lines 23-40, col. 3 line 62-col. 4 line 34) to be used thereby allowing specific user to reject callers or certain calling phone numbers (col. 4 lines 35-67). [Office Action, p. 11]

The Examiner concludes that

It would have been obvious for anyone of ordinary skill in the art at the time of invention to utilize the teachings of Kurganov or Trossen into the teachings of Morganstein in order to provid[e] for a more flexible system that allows subscribers the ability to predefine context-specific information to be used by external trusted party so that only calls from the trusted party are received. [Office Action, p. 11]

Regardless of whether the Examiner’s previous assertions are correct, Applicants amend claims 16, 19, and 22 to teach additional elements. Applicants respectfully assert that Morganstein in view of Kurganov or Trossen do not teach or suggest each and every element of

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claims 16, 19, and 22 as amended and that there is no suggestion or motivation to modify Morganstein by Kurganov or Trossen to teach claims 16, 19, and 22. Therefore, Applicants respectfully request withdrawal of the rejection under 103(a) and allowance of claims 16, 19, and 22.

With regard to the amendments, Applicants note that claims 16, 19, and 22 are amended to teach detecting an authenticated identity of said screening party. The specification of the present invention supports the amendment throughout, and for example, in paragraphs 0095, 0149, 0159 and Figures 4 and 5. Next, Applicants note that claims 16, 19, and 22 are amended to teach adjusting said context to indicate said identity of said screening party and said regulated path to said screening party. The specification of the present invention supports the amendment throughout, and for example, in paragraphs 0159. Further, Applicants note that claims 16, 19, and 22 are amended to teach distributing said adjusted context to said intended second party. The specification of the present invention supports the amendment throughout, and for example, in paragraphs 0159, 0185, and 0198.

Applicants note that both Kurganov and Trossen describe the entity determining whether to screen a call by transferring the call to voice mail (Kurganov, col. 2, lines 42-46, col. 3, lines 52-67, Trossen, col. 4, lines 6-10, lines 50-52); in contrast, claims 16, 19, and 22 are amended to indicate that the screening party identity is authenticated, where inherent to an authenticated identity is an individual screening party. Further, Applicants respectfully assert that neither of Kurganov or Trossen teaches or suggests modification to teach adjusting the context for a call to indicate the authenticated identity of the screening party and the regulation of the call and distributing the adjusted context to the intended second party. Therefore, Applicants respectfully assert that Morganstein in view of Kurganov or Trossen does not teach or suggest at least one element of claims 16, 19, and 22 and therefore the rejection under 103(a) should be withdrawn and the claims allowed.

Claims 17, 18, 20, 21, 23, and 24

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Regarding claims 17, 18, 20, 21, 23, and 24, Applicants respectfully propose that because Morganstein in view of Kurganov or Trossen no longer anticipates the independent claims 16, 19 and 22 upon which these dependent claims rely, then Morganstein in view of Kurganov or Trossen does not anticipate these dependent claims 17, 18, 20, 21, 23, and 24 and the dependent claims should be allowed.

2. Claims 55-65 are not obvious under Morganstein in view of Kurganov or Trossen and further in view of Farris

Claims 55-65 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morganstein in view of Kurganov or Trossen and further in view of Farris et al. (6,122,357, hereinafter Farris). [Office Action, p. 19] The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Regarding claims 55-65, Applicants respectfully assert that because independent claims 1, 6, and 11 are not obvious under Morganstein in view of Kurganov or Trossen, then these dependent claims 55-65 which on claims 1, 6, and 11 are also not obvious under Morganstein in view of Kurganov or Trossen and Farris and the dependent claims should be allowed.

In addition, regarding claims 55 and 60, the Examiner cites Morganstein in view of Kurganov or Trossen as failing to teach “the context comprises location of the caller and the callee.” [Office Action, p. 19] Regarding claims 57 and 62, the Examiner cites Morganstein in view of Kurganov or Trossen as failing to teach the context comprising the “type of telephony device.” [Office Action, p. 21] In addition, regarding claims 58 and 63, the Examiner cites Morganstein in view of Kurganov or Trossen as failing to teach context comprising the “type of billing plan.” [Office Action, p. 21]

Following each statement of what Morganstein in view of Kurganov or Trossen fails to teach, with regard to claims 55-65, the Examiner rejects each claim on the same basis that:

Farris teaches providing enhanced services through double SIV and personal dial tone (title, abstract) wherein the identity of a caller and callee is determined via speaker identification/verification (SIV) on audio signals received

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from users (col. 11 lines 32-42, col. 35 lines 18-40) enabling for call restrictions to be implanted from any location and different types of telephony devices (see pay-phone or hotel room telephony – column 14). Farris discloses the service may utilize a variety of different networks (col. 8 lines 12-14).

It would have been obvious for anyone of ordinary skill in the art at the time of the invention to modify the processor as taught by Morganstein in view of Kurganov or Trossen to use double SIV as taught by Farris for the benefit of authenticating both the caller and callee parties and thereby providing for a more flexible system that “challenges” both the callee and calling party before implementing call restrictions as taught by Farris.” [Office Action, pp. 20-23]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that a prima facie case of obviousness is not established because Farris does not teach the elements in claims 55, 57, 58, 60, 62, and 63 that the Examiner cites Morganstein in view of Kurganov or Trossen as failing to teach. In particular, Applicants respectfully assert that even if Farris discloses a service that detects the identity of the caller and callee to enable call restrictions from any location and from different types of telephony devices, this type of service does not teach or suggest detecting a context of a call that includes the geographical location of the caller and callee, detecting the types of telephony devices used in the call, or detecting the billing plans available. Therefore, Applicants respectfully assert that with regard to claims 55 and 60, 57 and 62, and 58 and 63, Applicants respectfully assert that neither Morganstein, Kurganov, Trossen nor Farris teaches detecting a context for a call wherein the context detected comprises the location of the caller and the callee, the types of telephony devices used or the type of billing plan available.

In addition, Applicants note that with respect to claims 55 and 60, Applicants amend claims 55 and 60 to clarify that the location of the claimed invention is the actual geographical location of at least one of the parties to the call and that the context based criteria include at least one rule for regulating a call based on at least one of the detected geographical locations. By clarifying that the location claimed is the geographical location of at least one of the first party or the second party and that a context based criteria rule regulates the call based on at least one of the geographical locations, Applicants assert that it is clear that Farris does not teach claims 55
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and 60 because Farris does not describe that the service determines a context of a call that includes the actual geographical location of one of the parties to the call and regulates the call based on rules for the geographical location. The specification supports the amendment throughout, and for example, in paragraphs 0098, 0101, 0102, 0123, 0124, and 0190.

In conclusion, prima facie case of obviousness under 103(a) is not established for claims 55, 57-60, 62-65 because at least the elements cited by the Examiner as not taught by Morganstein in view of Kurganov are also not taught by Farris. Because a prima facie case of obviousness under 103(a) is not established for claims 55, 57-60, 62-64, Appellants respectfully request allowance of claims 55, 57-60, 62-64.

In addition, with respect to claims 56, 61, and 65, Applicants respectfully assert that the Examiner's assertion that Morganstein in view of Kurganov or Trossen fails to teach the element of "the actual identity of calling and called party" fails to address each element of claims 55, 61, and 65. Claim 56, for example, reads:

56. **(Previously Added)** The method for regulating calls according to claim 1, said method further comprising:
- continually monitoring said context for said call once said communication channel is established between said first party and said second party, wherein said context for said call comprises an actual identity of said first party and an actual identity of said second party; and
 - only maintaining said communication channel between said first party and said second party if said continually monitored context is allowed when compared with said selection of context based criteria specified by said third party for said particular line.

The Examiner does not indicate how Morganstein in view of Kurganov or Trossen teaches or suggests continually monitoring the context of the call once the communication channel is established and only maintaining the communication channel between the first party and the second party if the continually monitored identities of the first party and second party are allowed under the context based criteria specified for the particular line. Further, the Examiner only cites Farris as disclosing identifying the actual identity of the calling and called party, but does not cite Farris as disclosing the continual monitoring of the identities of the calling and called parties. Applicants note, however, that Farris appears to describe a prisoner telephone

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service that prevents one prisoner from selling their telephone service rights to another prisoner by and IP periodically or constantly monitoring the outgoing speech signals from the prison line and if the IP does not detect the prisoner's voice, then the IP would direct the call to be disconnected. *Farris*, col. 28, line 50 – col. 29, line 6. However, since the Examiner's rejection alone does not support a prima facie case of obviousness with respect to claims 56, 61, and 65, Applicants respectfully request withdrawal of the rejection and allowance of the claims unless the Examiner states grounds of rejection that address each and every element of claims 56, 61, and 65.

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

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